

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

WATKINS et al

Atty. Ref.: 620-334; Confirmation No. 9948

Appl. No. 10/509,732

TC/A.U. 1624

Filed: September 30, 2004

Examiner: Leeser

For: CARBAMIC ACID COMPOUNDS COMPRISING A PIPERAZINE LINKAGE AS
HDAC INHIBITORS

* * * * *

January 18, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RULE 181 PETITION

Supplemental to the Amendment being filed concurrently herewith, the present Petition requests the Director's review of the Examiner's refusal to withdraw the lack of unity of invention determination and examine all of the pending claimed subject matter as also requested of the Examiner in the concurrently-filed Amendment.

Claims 80-84, 87-116 and 119-173 are pending.

The Examiner indicates that claims 80-173 are pending and under examination. The Examiner has maintained the restriction requirement of April 17, 2007 and made the requirement final. Reconsideration and withdrawal of the restriction requirement are requested of the Examiner in the concurrently-filed Amendment in view of the

amendments, which are believed to moot the basis for the lack of unity of invention determination.

Absent the Examiner's withdrawal of the restriction requirement, the Director is requested to grant the present Rule 181 Petition and direct the Examiner to withdraw the lack of unity determination and examine the full breadth of the claims. The present Rule 181 Petition is believed to be timely filed, pursuant to 34 CFR § 1.144 and MPEP § 821. A fee is not believed to be required for consideration of the present Rule 181 Petition as the same is only believed to be required due to the Examiner's error. The Office is authorized however, such as by the attached Transmittal Letter, to charge the undersigned's Deposit Account 14-1140 for any fee required for consideration of the present Rule 181 Petition.

The Examiner's lack of unity determination and election requirement of April 17, 2007 asserted the claims contained the following allegedly separately patentable Groups of subject matter:

Group I. Claims 80-140, 143, 146-1 63 and 165-1 73 drawn to carbarnic acid piperazine compounds when Cy is a pyridine, methods of treating and compositions of these compounds.

Group II. Claims 80-140, 143, 146 and 165-1 73 drawn to carbamic acid piperazine compounds when Cy is a pyrimidine, methods of treating and compositions of these compounds.

Group III. Claims 80- 140, 143, 146- 163 and 165- 173 drawn to carbarnic acid piperazine compounds when Cy is a bicyclic ring containing one nitrogen atom (that is benzopyrrole), methods of treating and compositions of these compounds.

Group IV. Claims 80- 140, 143, 146- 163 and 165- 173 drawn to carbamic acid piperazine compounds when Cy is a bicyclic ring containing one or more chalcogens (that is benzofuran or benzothiophene), methods of treating and compositions of these compounds.

Group V. Claims 80-173, drawn to carbamic acid piperazine compounds which do not fall within the scope of Groups I to V, methods of treating and compositions of these compounds.

The applicants elected the subject matter of the Examiner's Group V, with traverse, in the Response of May 17, 2007.

The basis of the Examiner's lack of unity of invention assertion was that

"the inventions listed as Groups I to V do not relate to a single general inventive concept under 35 USC 121 or PCT Rule 13.1 because:

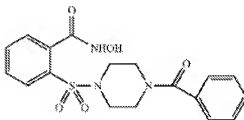
...

at least one Markush alternative is not novel because prior art by Bedell, L., et al., U.S. 6,380,258 and U.S. 7,115,632 anticipates group V, thus the lacking of unity of invention has been found." See pages 3-4 of the Office Action of April 17, 2007.¹

The pending claims are submitted to be patentable over U.S. Patent No. 7,115,632, as well as U.S. Patent Nos. 6,696,449 and 6,683,078 for at least the following reasons.

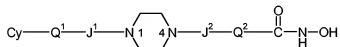
¹ The Office Action of July 19, 2007 confirms, in contradiction to the alleged basis for the lack of unity determination, that the elected subject matter (i.e., the subject matter of the Examiner's Group V) is patentable over U.S. Patent No. 6,380,258. The applicants note in this regard however that the application from which U.S. Patent No. 6,380,258, issued is a grand-parent of the application from which U.S. Patent No. 7,115,632 issued. The Examiner is again requested to make U.S. Patent No. 6,380,258, of record by listing the same on a PTO -892 Form. See Response filed May 17, 2007.

The Examiner is understood to believe that the following compound described in column 38, lines 5-10 of U.S. Patent No. 7,115,632, allegedly anticipates claims 80, 81, 85, 98, 116, 117, 138-141, 145, 146, 163, 164 and 168:

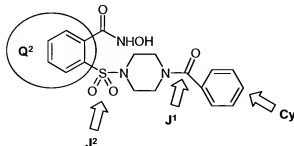


The Examiner asserts that the "same compound is also found in" U.S. Patent Nos. 6,696,449 and 6,683,078 . See page 12 of the Office Action dated July 19, 2007.

Claim 80, for example, however provides a compound of the following formula:



When compared with the compound cited by the Examiner, the applicants believe that the -Q²- group of the claimed structure is a 1,2-phenylene group in the cited compound of the cited art. More specifically, the following reproduction of the structure cited by the Examiner identifies what are believed to be structures corresponding to the claimed structures:



The 1,2-phenylene group of the structure of the cited art, corresponding to $-Q^2-$ of the claimed structures, is believed to be an example of a C_{5-20} arylene group.

The pending claims do not include compounds however wherein $-Q^2-$ is a C_{5-20} arylene group or other group corresponding to a structure of the cited compound of the cited art.

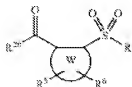
The claims are submitted to be novel over the teachings of U.S. Patent No. 7,115,632 which was the basis for the alleged lack of unity determination. The claims are similarly patentable over "The same compound found in" U.S. Patent Nos. 6,696,449 and 6,683,078.

Withdrawal of the lack of unity of invention and examination of all of the claimed subject matter are requested.

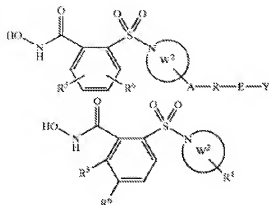
Grant of the present Rule 181 Petition and withdrawal of the lack of unity of invention by the Director and examination of all of the claimed subject matter by the Examiner are requested.

For completeness, the applicants note that each of the three cited patents require the above-noted 1,2-phenylene group.

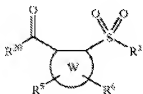
Specifically, U.S. Patent No. 7,115,632 describes compounds of the following formula:



U.S. Patent No. 6,696,449 describes compounds of the following formula:



U.S. Patent No. 6,683,078 describes compounds of the following formula:



The pending claims do not include Q² as a C₅₋₂₀arylene.

The claims are patentable over the cited art.

Withdrawal of the lack of unity of invention and examination of all of the claimed subject matter are requested.

WATKINS et al
Appl. No. 10/509,732
January 18, 2008
RULE 181 PETITION

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /B. J. Sadoff/
B. J. Sadoff
Reg. No. 36,663

BJS:
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100